

## **REMARKS**

Applicant appreciates the Examiner's comments from the interview of February 10, 2006 and provides the below remarks responsive to these comments.

### **Claim Amendments**

Claim 1 was amended to incorporate the limitations of claims 2, 3, 6, 10, 11, and 12. Claim 1 was further amended to incorporate: obtaining a current vehicle mileage (Paragraph [0023]) with a personal digital assistant (Paragraph [0013]); service items as a function of mileage (Paragraph [0024]); and selecting service items (Paragraph [0024]). Claim 2, 3, 6, 10, 11 and 12 were canceled. New claims 32 – 43 were added. No new matter has been added.

### **Rejection under 35 U.S.C. § 112**

The Examiner rejected claims 1-13 as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 1 stand rejected for reciting "in a memory device" and claim 12 is rejected for reciting "new repair order."

While not agreeing with the basis of the rejections, the claims have been amended to address the alleged deficiency. Applicant respectfully submits that the rejections are overcome. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, are respectfully requested.

### **Anticipation Rejection**

Claims 1-13 stand rejected as allegedly anticipated by Patent No. 6,609,050 to Li ("Li"). In view of the amendments and the remarks provided herein, reconsideration and withdrawal of the rejection are respectfully requested.

As the Examiner is well aware, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil. Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). Applicant respectfully submits that Li does not disclose nor suggest each and every element of the independent claim 1 or any claim depending therefrom. Consequently, the rejection over Li should be reconsidered and withdrawn.

Li is directed to a computer-based warranty administration system that provides vehicle-specific service. Specifically, Li alleges a system that uses a dialog manager to collect data from a user and an artificial intelligence ("AI") based reasoning module that analyzes the collected data to diagnose the vehicle. The system of Li then uses the diagnosis and the collected data to create a work order. The reference also discloses a dialog manager that collects service information via a computer interface.

In contrast, claim 1, as amended, recites: "transmitting the vehicle identifier and said current vehicle mileage over a wireless communication link . . . transmitting said data set and a list of selected service items to the PDA." Li neither discloses nor suggest these features. The reference does not even contemplate a wireless network or a PDA for any task, much less a wireless network for transmitting the vehicle identifier or communicating the repair order. Indeed, no suggestion to this effect is found in the

reference as Li did not contemplate the problem addressed by the Applicant. For at least these reasons, the anticipation rejection over Li should be reconsidered and withdrawn.

Each of claims 4-5, 7-9, 13 and 32-43 depends, either directly or indirectly, from claim 1, which as stated is patentable over Li. Accordingly, additional reasons for patentability of each of these claims will not be proffered.

Reconsideration and withdrawal of the anticipation rejection over Li are respectfully requested.

### **Obviousness Rejection**

Claims 1-13 stand rejected as allegedly obvious in view of Li. In support of the obviousness rejection, the Examiner asserts that “a work order is inherently a repair order.”

As a preliminary matter, Applicant objects to the Examiner’s attempted definition of terms in the claims and/or specification. As the Examiner is well aware, the specification must be interpreted in light of the broadest possible meaning. It follows that the Examiner is not authorized to define claim language in Applicant’s specification.

Because the Office has not raised an issue regarding the terms defined in the specification, the Examiner’s attempted characterizations of these terms is inappropriate. Applicant submits that the Computer Dictionary, 3ED, Microsoft Press 1997, does not contain the broadest possible meanings and therefore may not be considered limiting.

Notwithstanding, the obviousness rejection should be withdrawn regardless of whether a work order and a repair order are inherently the same. Specifically, Li fails to

disclose or suggest certain recitations of claim 1, as outlined above. Accordingly, the reference can not render claim 1, or any claim depending therefrom, unpatentable.

### CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance. A notice to this effect is respectfully requested.

If any point remains that is deemed best resolved through a telephonic conversation, the Office is hereby requested to contact the undersigned directly.

Although an extension of time is not deemed necessary, the Office is hereby requested and authorized to charge any extension of time fees, or any other fee required to maintain the application pending, against Deposit Account No. 04-1679 to Duane Morris LLP.

Respectfully Submitted,



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